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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,299	04/18/2001	Naoko Iwami		7838

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EXAMINER

TON, DANG T

ART UNIT PAPER NUMBER

2666

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/836,299

Applicant(s)

IWAMI ET AL.

Examiner

DANG T. TON

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23,25,26,28-30,32,33,35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23,25,26,28-30,32,33,35 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 23,25-26,28-30,32-33, and 35-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 5,604,737. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following :

For claims 23,25-26,28-30,32-33, and 35-36 , the claims 1-4 of the patent number 5,604,737 disclose a

a voice communication system including a line switching network to which telephones are connected, a packet switching network to which communication terminals are connected and which has a communication address scheme different from a telephone number scheme of the line switching network, and a communication server connected to the line switching network and the packet switching network and assigned a communication terminal address on the packet switching network, wherein:

each of the communication terminals comprises:

means for transmitting a voice communication request when an apparatus with which a communication is desired is a telephone connected to the line switching network, and performing communication control between the communication server and the communication terminal to establish a connection between the communication terminal and the communication server, and the voice communication request including the telephone number of the telephone, and

the communication server comprises:

means for receiving the voice communication request transmitted from the communication terminal to the communication terminal address of the communication server, and performing communication control between the communication server and the communication terminal which has transmitted the voice communication request to establish a connection between the communication server and the communication terminal;

means for performing communication control between the communication server and a telephone having a telephone number included in the received voice communication request to set the communication server and the telephone in a communication available state; and

means for receiving voice information transmitted from the telephone having the telephone number, editing the voice information into packets, and transmitting the packets to the communication terminal, while receiving packets transmitted from the communication terminal, and transmitting the voice information in the packets to the telephone having the telephone number;

wherein the communication terminal further includes:

voice inputting means for inputting voice information;

voice encoding means for encoding the inputted voice information;

voice decoding means for decoding the encoded voice information in received packets; and

voice outputting means for outputting the decoded voice information;

wherein the communication server further includes:

voice encoding means for encoding voice information from the telephone received through the line switching network;

means for editing the encoded voice information into packets and transmitting the packets to the communication terminal through the packet switching network;

voice decoding means for decoding the voice information in the packets from the communication terminal received through the packet switching network;
and

means for transmitting the decoded voice information to the telephone through the line switching network;

wherein the communication terminal further comprises:

means for allowing a user to select transmission of a mail to another communication terminal on the packet switching network with which a communication is desired, when a voice communication negating response is returned from the communication terminal as a result of transmitting a voice communication request to the communication terminal, and transmitting the mail to the communication terminal without inputting a communication address of the communication terminal when the user selects the transmission of the mail (see claims 1-4 of the patent).

For claims 23,25-26,28-30,32-33, and 35-36 , The applicant's claims merely broaden the scope of the claims 1-4 of the patent number 5,604,737 by eliminating the terms " when

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an apparatus with which a communication is desired is a telephone connected to said line switching network" and " said voice communication request including the telephone number of the telephone" from the claim 1 of the patent. It has been held that the omission of an element and its function is an obvious expedient if remaining elements perform the same function as before. In re karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969) ; omission of a reference element whose function is not needed would be obvious to one skilled in the art.

For claims 28-29 and 35-36, the claims 1-4 of the patent number 5,604,737 discloses all the subject matter of the claimed invention with the exception of ringing tone and off hook in a communications network. However, the ringing and off hook are well-known in the telephone network. Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to use the ringing and off hook in the claims 1-4 of the patent.

The ringing and off hook can be implemented/modified into the claims 1-4 of the patent since it does teach voice network (telephone network). The motivation for using ringing and off hook into the communications network of claims 1-4 of the patent

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being that it provides a connecting and disconnecting a telephone call from and to the network.

3. Applicant's arguments filed 6/27/2005 have been fully considered but they are not persuasive.

In the remarks of 6/27/2005, applicant traverses the rejection under obviousness type double patenting. The traversal is based on ground that the claims of the patent does not teach first unit and second unit. This argument is not found to be persuasive. Applicant's attention is directed at claim 1 means for transmitting is considered as second unit and means for receiving is considered as the first unit.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANG T. TON whose telephone number is 571-272-

3171. The examiner can normally be reached on MON-WED, 5:30 AM-6:00 PM and
Thur 5:30-9:30 A.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RAO SEEMA can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. Ton



DANG TON
PRIMARY EXAMINER